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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/616,605 | 07/14/2000 | Scott A. Kliger | 2182.1011-001 | 6154 |

7590

09/23/2004

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EXAMINER

GEREZGIHER, YEMANE M

ART UNIT

PAPER NUMBER

2144

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|---------------------|---------------|--|
| Application No. | Applicant(s) | |
| 09/616,605 | KLIGER ET AL. | |
| Examiner | Art Unit | |
| Yemane M Gerezgiher | 2144 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,2,6-11 and 15-20 is/are rejected.
- 7) ☒ Claim(s) 3-5, 12-14 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 0200 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

1. Amendment A, received on 05/11/2004 has been entered.

Claims 1-21 are pending.

Allowable Subject Matter

2. Claims 3-5, 12-14 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-2, 6-11, and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al (U.S. Patent Number 5,933,811) in view of Landsman et al. (U.S. Patent Number 6,785,659).

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As per claims 1, 10 and 19, Angles disclosed a method and a system of delivering customized advertisements within interactive communication systems. Angles disclosed a consumer requesting an electronic page from a content provider/Web server, and the content server returning the requested page having therein embedded advertisement request, the client computer executing advertisement request received from the Web server and upon execution establishing a communication session with an ad server (See Figures 3 & 4, Column 2, Lines 62 through Column 3, Line 5). Angles recited, "After obtaining the advertisement request, the content provider embeds the advertisement request into its electronic documents. When a registered consumer accesses a content provider's website, the content provider website transfers the electronic document and the embedded advertisement request to the consumer's computer. The embedded advertisement request directs the consumer computer to invoke the referenced content provider script in the advertisement provider computer." (See Column 3, Lines 40-49). Angles showed a consumer receiving an executable program enabling the browser at the client computer to display the customizable advertisement sent from the advertisement server. See Column 3, Lines 23-28 and Figs. 3 and 4. Since the described method/system is used through the means of computers,

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"a computer program comprising a computer usable medium comprising a set of computer program instructions embedded on the computer usable medium, including instructions to download a web page file from a web server", (recited in claim 19) were inherently disclosed by Angles.

Angles disclosed the claimed limitation ("determining user profile parameters for constricting customizable advertisements; and using the user profile parameters as input to the advertisement program when constructing the customizable advertisement") as recited in claims 2, 11, and 20. See Column 3, Lines 6-17 ("The advertisement provider's computer stores demographic information about consumers, and sends customized advertisements to the consumers based on the consumers demographic profile and tracks consumer responses to the customized advertisements. For example, when accessing a content provider's website, a consumer with a demographic profile indicating an interest in farming would be sent customized advertisements for farm products by the advertisement provider. Customer requests for more information about the advertised farm products are also monitored."), and Column 3, Lines 56-64 ("The advertisement provider uses the consumer member code to identify the consumer's demographic profile and preferences. The advertisement provider then selects an appropriate advertisement

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based on the consumer's profile and sends the customized advertisement to the consumer computer. The consumer computer then merges the content provider's electronic document with the advertisement provided by the advertisement provider to create a single displayed document to the consumer."). Angels taught the advertisement request embedded with in the document been populated with advertisement content by the advertising server. See Column 8, Lines 58-61.

Angels recited, "Referring to FIG. 3, an overview of the process of a consumer requesting an electronic document is shown. At start state 300 the process initializes and moves to state 302 wherein the consumer computer 12 requests an electronic page 32 from the content provider computer 14. As discussed in more detail below, the consumer computer 12 uses Internet browsing software (not shown) to access the content provider's URL address. The consumer browser software then accesses an electronic document 32 stored on the content provider computer 14.

Moving to state 304, the content provider computer 14 sends the electronic document 32 and the embedded advertisement request to the consumer computer 12.

Proceeding to state 306, the consumer computer executes the advertisement request 26 and establishes a communications

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link with the advertisement provider computer 18.

Proceeding to state 308, the advertisement request 26 directs the advertisement provider computer 18 to execute a content provider script, which contains the content provider member code. In addition, during state 308, the advertisement provider computer 18 obtains the consumer member code 22 stored on the consumer computer 12". See Column 8, Lines 33-54 and Fig. 3.

Angles substantially disclosed the claimed invention as claimed. Angles taught constructing the customized advertisement at a server side and sending the constructed advertisement to a client machine where it got integrated with the web page and presented to the targeted consumer.

However, Angles did not explicitly teach requesting an applet program from an applet server that specifically specify how to generate the requested advertisement and running an applet program at a client machine to construct the image representation of the personalized advertisement content.

However, as evidenced by the teachings of Landsman it was well known in the art at the time of the invention, to request such a script/applet program (See Abstract, Column 17, Line 37 through Column 18, Line 47) from a server that specifying the creation of a customized advertisement and executing the

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downloaded script/applet and to produce a customizable advertisement. See Figures. 1B, 1E, 2A, 2B, 10 and Column 9, Line 53 through Column 10, Line 22. Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Landsman related to executing an applet at a client side to construct a customized advertisement banner and have modified the teachings of Angles related to delivering customized electronic advertisements constructed at a server system and delivering the constructed customized advertisement to the client system, because "such a technique would likely provide considerable economies to advertisers in saved labor, time and cost in terms of both inserting advertisements into web page files, and later changing any of those advertisements." See Landsman Column 9, Lines 15-19.

Response to Arguments

5. Applicant's arguments with respect to claims 1, 10 and 19 have been considered but are moot in view of the new ground(s) of rejection.


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Conclusion

6. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Yemane Gerezgiher whose telephone number is 703-305-4874 or (571) 272-3925 effective October 25, 2004. The examiner can normally be reached on Monday- Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, William Cuchlinski, can be reached at (703) 308-3873 or (571) 272-3925 effective October 25, 2004.

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